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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,075

09/10/2003

Ryan W. Cuddy

112300-1679

6174

29159

7590

05/22/2009

K&L Gates LLP

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EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

05/22/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary	Application No. 10/660,075	Applicant(s) CUDDY ET AL.	
	Examiner William H. McCulloch	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29,31-40 and 42-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29,31-40 and 42-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to amendments received 1/27/2009. Claims 1-29, 31-40, and 42-70 are pending in the application.

Drawings

2. The drawings are objected to because Figure 5, step 122 states "GAMING DEVICE PROVIDES BONUS VALUE OPPURTUNITY." Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 5, 29, 34, 51, and 63 (and claims dependent thereon) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Amended claim 1 recites that the gaming device is programmed to “provide a player an award based on the number of locations the symbols is moved to before the symbol moves to the first location, said award being separate from any value associated with any of the locations the symbol is moved to.” Claims 5, 29, 34, 51, and 63 recite substantially similar subject matter. The specification does not support this new feature. Appropriate correction is required. See below with regard to a related rejection under 35 USC 112, second paragraph.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 5, 29, 34, 51, and 63 (and claims dependent thereon) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly

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point out and distinctly claim the subject matter which applicant regards as the invention.

As described above, claim 1 recites that the gaming device is programmed to “provide a player an award based on the number of locations the symbols is moved to before the symbol moves to the first location, said award being separate from any value associated with any of the locations the symbol is moved to.” Claims 5, 29, 34, 51, and 63 recite substantially similar subject matter. The first portion of the claim quotation (which is not underlined) indicates that an award is provided *based upon the number of locations that the symbol lands on*. This feature implies that there must be some value associated with those locations in order to generate an award based upon the number of locations. Therefore, it is simply not possible to qualify the award as “being separate from any value associated with any of the location the symbol is moved to.” Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-29, 31-40, 42-52, 55-56, 59-60, 63-64, and 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,767,283 to Weiss (hereinafter Weiss) in view of U.S. 6,409,172 to Vancura (hereinafter Vancura).

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Regarding claims 1-28, 51-52, 55-56, and 59-60 Weiss teaches a gaming device and method comprising the following limitations:

- A primary game operable upon a wager by a player, including at least one input device configured to receive an input of a wager (see at least 3:10-67);
- A plurality of locations, which includes a first location (e.g., “Easy Street” in the first bonus), wherein the plurality of said locations form a path (see at least figs. 1 and 3-5, and descriptions thereof);
- A plurality of awards associated with a plurality of said locations along the path (see e.g., elements 41 in fig. 4);
- At least one symbol adapted to make a plurality of moves to a plurality of the locations (see e.g., element 35 in fig. 4);
- At least one setback condition associated with at least one of the locations along the path (see e.g., elements 43 in fig. 4);
- At least one advance condition associated with at least one of said locations along the path (see e.g., elements 41 and 46 in fig. 4);
- A display device operable to display said symbol and the locations (e.g., element 2 in figs. 2-5);
- A processor operable with the display device to control the gaming device and at least one memory device that stores a plurality of instructions executable by the processor to operate the game (e.g., processor “P” in 3:31-33, which is necessarily programmed to operate the device as described by Weiss);

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- Repeating the steps of (a) causing the symbol to move to at least one location along the path toward the first location and (b) relocating the symbol to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition, until the symbol moves to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);
- Repeating the steps of (a) causing the symbol to move to at least one location along the path toward the first location, (b) providing a player any award associated with the location of the symbol, and (c) relocating the symbol to one of the locations along the path further from the first location of the symbol moves to the location associated with the setback condition, until the symbol moves to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends

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on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);

- A processor operable to provide the player at least one award based on the number of different locations the symbol is moved to (see at least 4:1-28);
- A triggering event associated with said game (see at least 3:59-67), wherein after the occurrence of said triggering event: (a) the symbol is moved to at least one location along the path toward the first location (see at least 4:1-28), (b) the symbol is relocated to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition (see at least 4:16-19), repeating steps (a) to (b) until the symbol movement terminates when the symbol is moved to the first location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof), and the player is provided a total award based on any award associated with any of the locations the symbol is moved to and the number of locations the symbol is moved to before the symbol moves to the first location (see at least 1:65-2:14 and 4:29-58).

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Regarding claims 29, 31-40, 42-50, 63-64, and 67-68, Weiss teaches a gaming device comprising the following limitations in addition to those listed above:

- A primary game operable upon a wager by a player (see at least 3:10-67);
- A first location (see e.g., “Home” location in fig. 4);
- A second location (see e.g., “Easy Street” in fig. 4);
- A plurality of locations, wherein a designated plurality of said locations form a path between said first location and said second location (see at least figs. 1 and 3-5, and descriptions thereof);
- A plurality of awards associated with a plurality of said designated locations along the path (see e.g., elements 41 in fig. 4);
- At least one symbol adapted to make a plurality of moves to a plurality of the locations (see e.g., element 35 in fig. 4);
- At least one setback condition associated with at least one designated location along the path (see e.g., elements 43 in fig. 4);
- At least one advance condition associated with at least one of said designated locations along the path (see e.g., elements 41 and 46 in fig. 4);
- A display device operable to display said symbol and the locations (see e.g., element 2 in figs. 2-5);
- A processor operable with the display device to control the gaming device and at least one memory device that stores a plurality of instructions executable by the processor to operate the game (e.g., processor “P” in 3:31-

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33, which is necessarily programmed to operate the device as described by Weiss);

- Repeating the steps of (a) causing the symbol to move to different designated locations along the path from the first location toward the second location and (b) relocating the symbol to one of the designated locations along the path toward the first location and further from the second location if the symbol moves to the designated location associated with the setback condition, until the symbol moves to one of the locations that is not between the first location and the second location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);
- Repeating the steps of (a) causing the symbol to move to different designated locations along the path from the first location toward the second location, (b) providing the player any award associated with the location of the symbol, (c) relocating the symbol to one of the designated locations along the path toward the first location and further from the second location if the symbol moves to the designated location associated with the setback condition, until the symbol moves to one of the locations that is not between the first location

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- and the second location (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof);
- A processor operable to provide the player at least one award based on the number of designated locations the symbol is moved to before the symbol moves to one of the locations that is not between the first location and the second location (see at least 4:1-28);
 - A triggering event associated with said primary game (see at least 3:59-67), wherein after the occurrence of said triggering event the symbol is moved from the first location to one of the designated locations along the path toward the second location (see at least 4:1-28), the symbol is relocated to one of the designated locations along the path toward the first location and further from the second location if the symbol moves to the designated location associated with the setback condition (see at least 4:16-19), the symbol is moved to another one of the locations toward the second location and further from the first location wherein the movement of the symbol terminates if the symbol is moved to one of the locations that is not between the first location and the second location (see at least 1:65-2:14 and 4:29-58), and the player is

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provided an award based on the number of designated locations the symbol is moved to before the symbol moves to one of the locations that is not between the first location and the second location (see at least 4:1-28) (e.g., (1) repeatedly playing the bonus game, each time ultimately having a "Go Home" outcome, until the last play results in achieving an "Easy Street" game, and subsequently cashing out, or (2) playing the bonus game one or more times, each time having one or more moves, wherein the symbol never lands on a "Go Home" and ultimately ends on "Easy Street", and subsequently cashing out; see fig. 1 and descriptions thereof).

While Weiss teaches the invention substantially as described above, Weiss lacks in explicitly teaching the repetition *within the same play of a game* of the steps of (a) causing the symbol to move to at least one location along the path toward the first location (or along the path from a first to a second location) and (b) relocate the symbol to one of the locations along the path further from the first location if the symbol moves to the location associated with the setback condition (or relocate the symbol to one of the locations along the path toward the first location and further from the second location) *until the symbol moves to the first location (or a location that is not between the first and second location)*.

In a related disclosure, Vancura describes landing on a setback location that causes the player's symbol to move backward one or more spaces (see at least 7:22-25). Additionally, Vancura teaches that certain squares may allow players to acquire items that may later be exchanged for value (7:41-42). This teaching of Vancura

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suggests that the player be awarded based not only upon the number of credits shown on individual squares (such as shown in Fig. 7), but also awarding the player an additional award based on the number of squares that the symbol (“movable indicia”) lands upon. This teaching is interpreted to be an award that is *separate from* the value associated with the locations (e.g., a “WIN 50” in Fig. 7).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Weiss to include the non-terminating setback condition of Vancura in order to provide players a chance to continue playing the bonus game even though the player’s symbol has experienced a setback condition. One of ordinary skill in the art would have recognized the benefit of allowing the player to continue playing the bonus game even after experiencing a setback condition, in order to prevent the player from becoming discouraged from continued wagering on the gaming device.

10. Claims 53-54, 57-58, 61-62, 65-66, and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss in view of Vancura, and in further view of Admitted Prior Art.

The combination of Weiss and Vancura teaches the invention substantially as described above, but lacks in disclosing operating a game method through a data network including the Internet. In a previous Official Action, the Examiner took Official Notice that it was notoriously well known to those of ordinary skill in the art to operate gaming machines through a data network including the Internet in order to control gaming devices from a remote location. Applicant did not adequately challenge the facts for which Official Notice was taken and therefore those facts are considered

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Admitted Prior Art. See MPEP 2144.03. Thus, the above-mentioned claims are obvious in view of the teachings of Weiss and Vancura. One of ordinary skill in the art would have been motivated to modify the combination of Weiss and Vancura in order to allow a player to control gaming devices from a remote location.

Response to Arguments

11. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
5/12/2009

/Peter D. Vo/
Supervisory Patent Examiner, Art Unit 3714